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EXAMINER

MURDOUGH, JOSHUA A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/661,811 | Applicant(s) NATHAN ET AL. | |
| | Examiner JOSHUA MURDOUGH | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is responsive to Applicants' amendments received 4 June 2009.
2. This action has been assigned paper number 20091007 for reference purposes only.
3. Claims 43-79 are pending.
4. Claims 43-79 have been examined.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- a. “a first storage location” in at least claim 43;
- b. “a second storage location” in at least claim 43;
- c. “a user interface” in at least claim 43;
- d. “collection of an appropriate fee of number of credits” in at least claim 43;
- e. “disk drive” in at least claim 44;
- f. “areas of a single disk drive” in at least claim 45;
- g. “partitions of a single disk drive” in at least claim 46;
- h. “encryption level” in at least claim 50;
- i. “predetermined number of bytes” in at least claim 52;
- j. “repository of instances of media” in at least claim 53.

Claim Rejections - 35 USC § 112 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 43-60, 63, 64, and 69-79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

8. Claims 43 and 53 recite “a first storage location” and “a second storage location” as part of “a jukebox device.” As noted above, the specification does not make reference to either “a first storage location” or “a second storage location.” Figure 7 does show IDE controllers (78 and 80) with multiple hard disk drives (82, 84, 86, and 88). However, the IDE controllers and disk drives are part of the local server (22). In Figure 2, the jukebox devices (16) are shown as separate from the local servers (22). Therefore, these disk drives are not shown as part of the jukebox device. The Examiner, upon rereading the specification, could not find any indication that there were multiple storage locations in the jukebox as originally disclosed. In order to provide more relevant prior art, the Examiner has interpreted these claims as being directed toward a jukebox system instead of a jukebox device when applying the prior art.

9. Claims 44 and 54 recite a “jukebox device” which “comprise[s] first and second disk drive devices.” As noted in the preceding paragraph, the disk drives (82, 84, 86, and 88) are

shown as being in the local server (22) not in the jukebox device (16). Therefore, there is no indication in the original disclosure of two disk drives in the jukebox device.

10. Claims 45, 55, and 63 recite “the first and second storage locations respectively are located on first and second areas of a single disk drive device.” There is no disclosure of segmenting or dividing the storage area of a disk drive device in the original disclosure.

11. Claims 46, 56, and 64 recite “the first and second storage locations respectively comprise first and second partitions of a single disk drive device.” As noted in the preceding paragraph, there is no disclosure of segmenting or dividing the storage area of a disk drive device. Because partitioning is essentially dividing a drive into two parts, there is also a failure to disclose partitioning the disk drive device.

12. Claims 51 and 69 recite “each instance of media in the second plurality of instances of media is encrypted with a layer of encryption different from the first encryption level.” The Examiner has only been able to find one disclosure of an encryption method. This method includes using a block removed from the media to encrypt the subsequent block ([0011] and [0026]). However, there is no disclosure of a different encryption level.

13. Claim 73 recites “a jukebox device...comprising: at least one storage location configured to store instances of media available for playback via the jukebox device, the instances of media being divided into first and second subsets of media.” Applicants' original disclosure states “any one jukebox only stores *a subset* of the complete library of songs maintained by the central server at any one time” [emphasis added] [0005] and “[e]ach of the jukebox devices includes *a subset* of the master library on a local storage device of the jukebox” [emphasis added] [0023]. Therefore, the express disclosure of a jukebox only containing a single subset indicates that a

jukebox including multiple subsets was not in Applicants' possession at the time the application was filed.

Claim Rejections - 35 USC § 112 2nd Paragraph

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 43-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claims 43, 53, 61, and 71 each recite at least one "storage location" which stores "instances of media." As noted under the Claim Interpretations section below, White states "[C]onflicts [are] caused when two components want to use the same system resources, such as a specific location, or *address*, in memory." Because this expressly shows that a location cannot be used for multiple things and Applicants use a location to store multiple things, Applicants are believed to be using an alternate meaning of location. However, one of ordinary skill in the art would not understand what a storage location is, as used in the noted claims, given that it does not conform to the definition in the prior art.

17. Claims 75-77 are rejected because they apparatus claims which contain limitations, for which, one of ordinary skill in the art would not know what the corresponding structure is needed to infringe.

k. Claim 75 recites "after at least some instances not included in the first subset of media are searched for instances of media matching the search criteria." This limitation

is functional. However, functional limitations in an apparatus claim are given weight according to the structure required. For this limitation, one of ordinary skill in the art would not know if there is any structure required. Thus, the weight given to it is also unknown.

l. Claim 76 recites “the second subset of media is searched.” This limitation is also functional. Again, one of ordinary skill in the art would not know if there is any structure required to perform the function.

m. Claim 77 recites “the first and second subsets of media are searched.” Similar to the limitation in claim 76, this limitation is also functional. Similarly, one of ordinary skill in the art would not know if there is any structure required to perform the function.

18. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 43-45, 47-49, 53-55, 57-63, and 65-67, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles (US 5,481,509) in view of Applicants' Admitted Prior Art.

21. As to claim 43, Knowles shows:

n. A jukebox device **5**, comprising:

o. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media (Figure 4A, step 120) available for playback via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);

p. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the selected instance of media on the jukebox device ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5) following collection of an appropriate fee or number of credits (Steps 152 and 154),

22. Knowles does not expressly show:

q. a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.

r. wherein the first storage location is different from the second storage location.

23. However, Applicants admit "jukebox systems have in the past provided a feature which enables the user to search for songs on the central server from the jukebox and request an

immediate download of a desired song from the central server to the jukebox for an additional fee” (Specification, [0006]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to include a local server from which a user can download and play a desired song for an additional fee, because this would give the user access to a larger selection of songs.

24. As to claim 44, Knowles further shows:

s. the first and second storage locations respectively comprise first and second disk drive devices(Id.).

25. As to claim 45, Knowles further shows:

t. the first and second storage locations respectively are located on first and second areas of a single disk drive device (Column 1, lines 60-62 shows that there may be only one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).

26. As to claim 47, Knowles further shows:

u. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

27. As to claim 48, Knowles further shows:

v. the first and second storage locations are updatable independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

28. As to claim 49, Knowles further shows:

w. a selected instance of media from said second plurality of instances of media becomes at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

29. As to claim 53, Knowles shows:

x. A digital audiovisual distribution network, comprising:

y. a plurality of jukebox devices respectively located at a plurality of locations; and

z. a central server **100** operably connected to a repository **112** of instances of media distributable to the jukebox devices via the network (Column 5, lines 51-61);

aa. wherein each said jukebox device (Figure 2) comprises:

bb. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);

- cc. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5) following collection of an appropriate fee or number of credits (Steps 152 and 154),
30. Knowles does not expressly show:
- dd. a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.
- ee. wherein the first storage location is different from the second storage location.
31. However, Applicants admit “jukebox systems have in the past provided a feature which enables the user to search for songs on the central server from the jukebox and request an immediate download of a desired song from the central server to the jukebox for an additional fee” (Specification, [0006]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to include a local server from which a user can download and play a desired song for an additional fee, because this would give the user access to a larger selection of songs.
32. As to claim 54, Knowles further shows:
- ff. the first and second storage locations respectively comprise first and second disk drive devices (top/middle 52 in Figure 2).

33. As to claim 55, Knowles further shows:

gg. the first and second storage locations respectively are located on first and second areas of a single disk drive device (Column 1, lines 60-62 shows that there may be only one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).

34. As to claim 57, Knowles further shows:

hh. the second plurality of instances of media substantially mirrors the repository of instances of media operably connected to the central server (Column 5, lines 21-33).

35. As to claim 58, Knowles further shows:

ii. the first and second storage locations are updatable via the network independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

36. As to claim 59, Knowles further shows:

jj. an instance of media from said second plurality of instances of media selected for playback is at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of

“Video[s]” **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

37. As to claim 60, Knowles further shows:

kk. an instance of media stored in the repository of the central server, subsequent to user request, is downloadable to a storage location of one said jukebox device (Column 5, lines 21-33) for a third fee or number of credits (as evidenced by Figure 4A, step 136), the third fee or number of credits being higher than the second fee or number of credits (multiple prices are disclosed, if there are 3 prices, one is going to be the highest, one will be the middle, and one will be the lowest).

38. As to claim 61, Knowles shows:

ll. A method of operating a jukebox device, comprising:

mm. providing a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);

nn. receiving, via a user interface provided to the jukebox device (Figure 5, element 200), user input corresponding to a selection of an instance of media available for playback from the first and second pluralities of instances of media for playback on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5)

39. Knowles does not expressly show:

oo. providing a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits.

pp. wherein the first storage location is different from the second storage location.

40. However, Applicants admit “jukebox systems have in the past provided a feature which enables the user to search for songs on the central server from the jukebox and request an immediate download of a desired song from the central server to the jukebox for an additional fee” (Specification, [0006]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to include a local server from which a user can download and play a desired song for an additional fee, because this would give the user access to a larger selection of songs.

41.

42. As to claim 62, Knowles further shows:

qq. the first and second storage locations respectively comprise first and second disk drive devices (Id.).

43. As to claim 63, Knowles further shows:

rr. the first and second storage locations respectively are located on first and second areas of a single disk drive device Column 1, lines 60-62 shows that there may be only

one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).

44. As to claim 65, Knowles further shows:

ss. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

45. As to claim 66, Knowles further shows:

tt. updating the first and second storage locations independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

46. As to claim 67, Knowles further shows:

uu. making available on the first storage location, at least temporarily, a selected instance of media from said second plurality of instances of media (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

47. Claims 71-79 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of Shneidman (US 2006/0038794).

48. As to claims 71, 74, 76, and 77, Knowles shows:

vv. A jukebox device **5** configured to playback an instance of media selected by a user (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5), comprising:

ww. at least one storage location **52** configured to store instances of media available for playback via the jukebox device (Figure 4A, step 120), the instances of media being divided into first and second subsets of media, the first and second subsets of media being different from one another (Figure 4A, steps 120 and 124); and

xx. a user interface provided to the jukebox device configured to enable a user to select an instance of media from the instances of media in order to initiate playback of the selected instance of media on the jukebox device (“Touch the title of your choice” and various separated indexes of music, video, karaoke, etc., Figure 5),

yy. the user interface comprising a first display configured to enable a user to select the instance of media for playback from the first subset of media **18** for a first fee or number of credits (as evidenced by Figure 4A, step 136), and

zz. the display configured to enable a user to select the instance of media for playback from at least the second subset of media (Figure 4A, step 120) for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of

credits being greater than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower), and

aaa. second display screen configured to enable a user to select the instance of media for playback (Figure 5, element 220).

49. Knowles does not expressly show that the list of media is searchable.

50. Shneidman shows “multi-searchable jukebox type applications” (Paragraph [0063]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to include a search, as taught by Shneidman, in order to allow users to access the system and provide them with an easier method of finding and accessing the media.

51. As to claim 72, Knowles further shows:

bbb. the first display screen includes a list of artists for each said instance of media in the first subset of media (“Touch here to sort by title or artist” Figure 5).

52. Knowles in view of Shneidman teaches a list of artists being displayed on a jukebox.

However, it does not expressly teach the specific data recited in claim 73 (the album art).

Nevertheless, the difference(s) are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements.

The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see*

In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

53. As to claim 75, Knowles further shows

ccc. the second display is configured to display search results **220** after at least some instances of media not included in the first subset of media are searched for instances of media matching the search criteria.

54. As to claim 78, Knowles further shows:

ddd. the search results are selectable by the user in order to initiate playback of the selected search result by the jukebox device for the second fee or number of credits (as evidenced by Figure 4A, step 136).

55. As to claim 79, Knowles further shows:

eee. the first and second displays are each configured to allow a user to supply an additional fee or number of credits in order to make the selected instance of media play immediately after a currently playing instance of media (through element 20).

56. Claims 46, 56, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles in view of Waingrow (Unix Hints & Hacks).

57. Knowles shows as discussed above in regards to claims 43, 53, and 61; but does not expressly show:

fff. the first and second storage locations respectively comprise first and second partitions of a single disk drive device of the jukebox device.

58. Waingrow teaches the creation of partitions on a hard drive to separate data in order to prevent complete failure of the hard drive (Pages 14-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to create a formal separation on the hard drive, in the form of partitions in order to isolate each type of file. This way, if one File Allocation Table (FAT) became corrupt, the data on the entire hard drive was not lost but only one partition.

59. Claims 50, 51, 68, and 69 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of Bowman-Amuah (US 6,289,382).

60. Knowles shows as described above in regards to claims 43 and 61 but does not show the encryption of the media as claimed in these claims.

61. However, Bowman-Amuah shows the encryption of the media in a jukebox system (Column 90, lines 25-37) by use of different mechanisms (Columns 81-82, lines 55-19). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to encrypt the media as shown by Bowman-Amuah in order to prevent unwanted access to the media.

62. Claims 52 and 70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles and Bowman-Amuah as applied to claims 51 and 69 above, and further in view of Dunning (US 7,024,485).

63. The Knowles/Bowman-Amuah combination discloses as discussed above, but does not expressly disclose:

ggg. each instance of media in the second plurality of instances of media is missing a predetermined number of bytes, said missing bytes being stored in separate respective locations and being at least temporarily insertable into the respective instances of media to enable playback by the jukebox device.

64. However, Dunning shows a jukebox (Figure 2, 103) that splits the content file (Figure 3A, 2714) and only keeps a portion of it (Figure 3A, 2718). When the complete file is requested, the jukebox receives the other portion of the file (Figure 3C, 2734) and combines it with the part stored on the jukebox (Figure 3C, 2738). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Knowles to include the divided storage of Dunning for reasons including, preventing a complete copy of the file from residing on the jukebox where it could be copied (Dunning, Column 6, lines 24-25).

Claim Interpretations

65. The Examiner hereby adopts the following interpretations under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his

interpretation of the claims.¹ Additionally, these interpretations are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way.

66. The Examiner also presents the following findings in support of the above rejections or in addition to them:

hhh. “[J]ukebox systems have in the past provided a feature which enables the user to search for songs on the central server from the jukebox and request an immediate download of a desired song from the central server to the jukebox for an additional fee” (Specification, [0006]).

iii. “The local server is installed in close proximity to the jukebox” (Specification, [0009]).

jjj. The jukebox devices 16(a-f) are connected to local servers 22(a-f) (Specification, [0023]).

kkk. “‘Nonfunctional descriptive material’ includes but is not limited to music, literary works, and a compilation or mere arrangement of data” (MPEP § 2106.01).

lll. “USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight” (MPEP § 2106.01).

mmm. “[N]onstatutory music is not a computer component” (MPEP § 2106.01).

¹ While most definitions and other evidence are cited because these terms or concepts are found in the claims, the Examiner may have provided additional definitions or evidence to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

nnn. “USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate” (MPEP § 2106.01).

ooo. “[C]onflicts [are] caused when two components want to use the same system resources, such as a specific location, or *address*, in memory” [emphasis in original] (White, “How Computers Work,” Page 202).

ppp. **Location:** “*See address*¹ (definition 1).” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

qqq. **Address:** “**1.** A number specifying a location in memory where data is stored.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

rrr. **Enable:** “1 a : to provide with the means or opportunity... b : to make possible, practical or easy” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

sss. **Possible:** “2 a : being something that may or may not occur.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

67. As a result of the above noted findings, the Examiner makes the following interpretations:

ttt. Because Applicants admit “jukebox systems have in the past provided a feature which enables the user to search for songs on the central server from the jukebox and request an immediate download of a desired song from the central server to the jukebox

for an additional fee,” (Specification, [0006]) applying a particular fee for a song from a particular location (the central server) is concluded to be old and well known in the art.

uuu. Because printed matter such as literary works are discussed along with music, the same standard for determining patentable weight should be used for both.

vvv. Because applying a particular fee for a song from a particular location is old and well known, the Examiner concludes there is no new and unobvious functional relationship between the music and the storage medium.

www. Because there is no new and unobvious functional relationship between the music and the storage medium, the Examiner need not give patentable weight to the music.

xxx. Because the local server is in close proximity to the jukebox and because the local server and the jukebox device are assigned separate reference numbers (22 and 16 respectively) they are concluded to be separate devices.

yyy. Because the local server and the jukebox device are separate devices, the multiple hard disk drives (82, 84, 86, and 88) shown in Figure 7 are not part of the jukebox device.

zzz. Because of the above cited definitions of “location” and “address” and the passage by White, the Examiner’s position is that one of ordinary skill in the art would understand the term “location” to reference an address, or single place in a memory. This place can only be used for storing a single piece of data, because if the place is used for two pieces, conflicts will arise.

aaaa. Because “enable” can mean “to make possible” and “possible” can refer to “something that may or may not occur,” the Examiner concludes that enabling something does not require that something to occur.

Response to Arguments

68. Applicant's arguments, see Remarks filed 4 June 2009, with respect to the rejection(s) of claims 43-45, 47-49, 53-55, 57-63, and 65-67 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of Applicants' Admissions.

69. Applicant's arguments filed 4 June 2009 have been fully considered but they are not persuasive.

70. Applicants argue:

71. "[T]here is nothing inherently "wrong" with reciting the functional aspects of a structure" (Remarks, Page 12, Paragraph 1).

72. Examiner's response:

73. The Examiner agrees that there is nothing wrong with claiming an apparatus functionally. The Examiner has not rejected or objected to any claims for being functional. However, when a claim limitation does not impact the structure, in the case of an apparatus claim, the weight given to the limitation is less than when the limitation requires some particular structure. This is because "claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" (MPEP § 2114).

74. Applicants argue:

75. “Indeed, in computer-related inventions, the structure of programmed logic circuitry often is best understood in terms of its function. Such certainly is the case here, where claims 43 and 53, for example, make it abundantly clear what types of media each storage location stores (thereby clearly emphasizing structure) and how and when each instance of media stored on a particular storage location can be played back (thereby explaining structure through function, e.g., in explaining how the logic circuitry is programmed within providing volumes of code)” (Remarks, Page 12, Paragraph 1).

76. Examiner's response:

77. The Examiner agrees that logic circuitry would be a structural element that would receive full patentable weight. However, Applicants have not disclosed “programmed logic circuitry” in their original disclosure, nor is it recited in their claims.

78. Applicants argue:

79. “Applicant notes that claim 61 is a method claim. Thus, to the extent that there is any objectionable functional or intended use language in claims 43 or 53, such is entirely proper within the context of a method claim” (Remarks, Page 12, Paragraph 3).

80. Examiner's response:

81. .The Examiner agrees that method claims are functional language and therefore, functional language must be given weight in a method claim. However, language that does not

require certain steps to be performed is given less patentable weight. For example, enabling something to happen does not require the action to be performed, but instead must make it possible for that action to be performed. The Examiner has provided the definitions for the words "enable" and "possible" above in support of this interpretation.

82. Applicants argue:

83. "Thus, the Office Action's indication that the phrase "'configured to enable' fails to make the limitation a positive recitation," to the extent understood or relevant, is inapposite, in that a computer-implemented element being "configured to" do something (1) is not inherently objectionable, (2) is a positive recitation (particularly in the context of claim 71), and (3) clearly and unambiguously denotes structure (again, particularly in the context of claim 71)" (Remarks, Page 14, Paragraph 3).

84. Examiner's response:

85. The Examiner agrees that "configured to" is not objectionable. However, the recitation of "configured to" does not make the remainder of the limitation automatically positive and directed towards a structure. All of the terms in the limitation must be considered to determine the appropriate weight to be given to the limitation. As noted by Applicants, claim 71 recites "configured to enable." While this phrase requires the enabling, or making possible, of the action that follows it, it does not require the action to be performed. If Applicants remove the word "enable" this limitation would be given additional weight.

86. Applicants argue:

87. “Knowles does not explicitly disclose or inherently require charging a different price for the playback of media based on the display screen from which an instance of media is selected. Being able to select instances of media -- regardless of whether those instances of media come from the same or a different storage location -- does not equate to charging a different price for the playback of an instance of media based on the display screen from which the particular instance of media is selected” (Remarks, Page 15, Paragraph 1).

88. Examiner's response:

89. As noted above, claim 71 recites “configured to enable” which requires the action to be possible and does not require the action to be performed. Removing “enable” from the paraphrased limitations would result in the limitation having more weight and the argument being persuasive.

Conclusion

90. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Calvin L Hewitt II/
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